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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,166	06/01/2006	Byoung-Mog Kwon	428.1069	2320
20311 7590 04/21/2008 LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016				
EXAMINER				
DAVIS, DEBORAH A				
ART UNIT		PAPER NUMBER		
1655				
MAIL DATE		DELIVERY MODE		
04/21/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/580,166

Applicant(s)

KWON ET AL.

Examiner

DEBORAH A. DAVIS

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7-12-08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a pharmaceutical composition for treating cancer comprising a Cinnamoni Cortex extract and a Zizyphi Fructus extract, does not reasonably provide enablement for preventing. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Applicant has reasonably demonstrated/disclosed that the claimed composition comprising Cinnamoni Cortex extract and a Zizyphi Fructus extract is useful for treating cancer. However, the claims also encompass using the claimed composition to prevent cancer which is clearly beyond the scope of the instantly disclosed/claimed invention. Please note that the term "prevent" is an absolute definition which means to stop from the occurring and, thus, requires a higher standard for enablement than does "treat", especially since it is notoriously well accepted in the medical art that the vast majority of afflictions/disorders suffered by mankind cannot be totally preventing with current therapies (other than certain vaccination regimes).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague, because it is unclear whether the compound of "Chemical Formula 1" is found in the extract of Cinnamoni Cortex and compound of "Chemical Formula 2" is found in the extract of Zizyphi Fructus, or if each compound is independent compounds added to the composition.

Claims 2 and 3 recites "a resulting extract" in lines 5 and 6 is vague because it is unclear as to whether the resulting extract refers to the Cinnamoni Cortex extract or another extract.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by L. Chen (CN 1371978) and as evidenced by CA Registry.

The claims are drawn to a pharmaceutical composition for treating cancer comprising a Cinnamoni cortex extract including a compound represented by Chemical Formula 1, and a Zizyphi Fructus extract including a compound represented by Chemical Formula 2, disclosed in the instant claim 1.

The reference of Chen discloses a pharmaceutical (health care liquor) and preparation thereof comprising alcoholic extracts of jujube (zizyphi Fructus) and cinnamon bark (Cinnamoni Cortex) as active ingredients for treating cancer (see entire abstract). Chen discloses preparing red dates (i.e. another name for Jujube) which is the fruit of Jujube and therefore meets the limitation of Zizyphi Fructus. In addition, as evidenced by the CA Registry, the structures of formulas 1 and 2 are known and therefore would be inherent to the composition of the disclosed reference of Chen (see CA Registry for formulas 1 and 2).

Therefore for reference is deemed to anticipate the instant claims.

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 5-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over L. Chen (CN 1371978) as evidenced by the CA Registry.

The reference of Chen discloses a pharmaceutical (health care liquor) and preparation thereof comprising alcoholic extracts of jujube (*Zizyphi Fructus*) and cinnamon bark (*Cinnamoni Cortex*) as active ingredients for treating cancer (see entire abstract). As evidenced by the CA Registry, the structures of Formulas 1 and 2 are known and therefore are inherent to the extracts disclosed by the reference of Chen (see CA Registry for formulas 1 and 2). In addition, the cited reference provides the same functional therapeutic effects of treating cancer, as instantly claimed. The reference of Chen also teaches extraction by alcohol. Consequently, the claimed extracts of *Zizyphi Fructus* and *Cinnamoni Cortex* appears to be anticipated by the cited reference.

In the alternative, even if the claimed pharmaceutical composition is not identical to the reference extract composition with regard to some unidentified characteristics, the differences between that which is disclosed and that which is claimed are considered to be so slight that the referenced composition is likely to inherently possess the same characteristics of the claimed composition, particularly in view of the similar characteristics which they have been shown to share. Thus, the claimed pharmaceutical composition would have been obvious to those of ordinary skill in the art within the meaning of USC 103.

Accordingly, the claimed invention as a whole was at least prima facie obvious, if not anticipated by the reference especially in the absence of sufficient, clear, and convincing evidence to the contrary.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over L. Chen (CN 1371978) and as evidenced by CA Registry.

The teaching of L. Chen have been set forth above but is silent with respect to the Cinnamoni Cortex extract and the Zizyphi Fructus extract being mixed in a ratio of 20:80 to 80:20 by weight.

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare a pharmaceutical composition comprising extracts of Cinnamon bark (Cinnamoni cortex) and Jujube (Zizyphi Fructus) extracts taught by Chen based on the beneficial teachings of treating cancer and other conditions therein. The adjustment of particular conventional working conditions (i.e. ratios of Cinnamoni Cortex and Zizyphi Fructus extracts) is deemed merely a matter of judicious selection and routine optimization, which is well within the purview of the skilled artisan.

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole was prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of the evidence to the contrary.

.Conclusion

No claims are allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBORAH A. DAVIS whose telephone number is (571)272-0818. The examiner can normally be reached on 8-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Deborah A. Davis
Patent Examiner
Art Unit 1655
April 2008

/Christopher R. Tate/
Primary Examiner, Art Unit 1655